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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,156	12/18/2001	Steven O. Markel	Inte.24USU1	9484

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EXAMINER	
QUELER, ADAM M	

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/026,156	MARKEL, STEVEN O.	
	Examiner	Art Unit	
	Adam M Queler	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 May 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *01/28/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Application filed 12/18/2001, and IDS filed 01/28/2002

2. Claims 1-18 are pending in the case. Claims 1, 9, 13, 14, 16, 17, and 19 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are not directed to statutory subject matter because the claimed subject matter: Does not fall within one of the four statutory classes of inventions under 101; and/or falls, by analogy, within the printed matter exception to 101.

Data structures do not fall within one of the four statutory classes of invention under 101: process, machine, manufacture, and composition of matter. A data structure is clearly neither a "process" nor a "machine." With regard to the other statutory classes, the Supreme Court in Diamond v. Chakrabarty, 206 USPQ 193 (S. Ct. 1980), has defined a "manufacture" as "the production of articles for use from raw materials prepared by giving to these materials new forms, qualities, properties, or combinations whether by hand labor or by machinery" and has defined a "composition of matter" as "all compositions of two or more substances and ... all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders, or solids." Id. at 195-196. Clearly, a data structure, per

se, cannot be considered a "manufacture" since a data structure is not produced from raw materials and has no tangible, physical form or structure. Likewise, a data structure cannot be considered a "composition of matter" since a data structure is not a composition of substances or composite articles as contemplated by the Supreme Court. Accordingly, since a data structure does not fall within one of the four statutory classes of inventions under 101, the claims are not directed toward statutory subject matter.

Lastly, a data structure is considered non-statutory subject matter by analogy to the "printed matter" exception under 101. See In re Miller, 164 USPQ 46, 49 (CCPA 1969). Like printed matter, a data structure, in and of itself, is merely an arrangement of data and nothing more. Furthermore, claims drawn to printed matter may be non-statutory even though the claims recite the structure on which the printed matter is printed:

> The *mere arrangement* of printed matter on a sheet or sheets of paper, in book form or otherwise, does not constitute "any new and useful art, machine, manufacture, or composition of matter," or "any new and useful improvements thereof," as provided in section 4886, of the Revised Statutes [the predecessor to 35 U.S.C. 101].

(emphasis in original). In re Russell, 9 USPQ 181, 182 (CCPA 1931). At best, the claims as a whole describe a data structure stored in a computer system. Accordingly, like printed matter "stored" on a sheet of paper, a data structure stored in a computer system fails to present statutory subject matter.

MPEP § 2106 states:

When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a

computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting").

Claims 1-16 are also non-statutory because they recite structures that are not tangibly embodied in a medium.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6-9 provides for the use of game shows, voting and creating a form, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 6-9 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for

example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al (US 20030196164A1, filed 9/15/1999).

Regarding independent claim(s) 1, Gupta discloses a user interface and input box for identifying content (Fig. 8, 262). Gupta discloses a prompt and input box for entering a start time that content will be displayed (Fig. 8, 268).

Regarding dependent claim(s) 9, Gupta discloses a user interface and input box for identifying content (Fig. 8, 262). Gupta discloses a prompt and input box for entering a start time and end time capable of selecting a particular frame (Gupta, para. 61).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 2-8, and 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta, and further in view of Bayeh et al (US006012098A, filed 2/23/1998).

Regarding dependent claim(s) 2 and 10, Gupta teaches that the content is stored in a database (para. 47). Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22).

Regarding dependent claim(s) 3, Gupta does not teach generating an HTML file. Bayeh teaches an XSL parser to generate an HTML file (col. 9, ll. 5-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to format the information as HTML because browsers expected to receive HTML (col. 2, ll. 52-53).

Regarding dependent claim(s) 4 and 11, Gupta does not teach generating an HTML file. Bayeh teaches a first XSL parser to generate a first HTML file (col. 9, ll. 5-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to format the information as HTML because browsers expected to receive HTML (col. 2, ll. 52-53).

Regarding dependent claim(s) 5 and 12, Gupta does not teach generating an HTML file. Bayeh teaches a second XSL processor for different presentation requirements, (col. 8, ll. 55-57), which would encompass a different device. It would have been obvious to one of ordinary skill in the art at the time of the invention to format the information as HTML because browsers expected to receive HTML (col. 2, ll. 52-53).

Regarding dependent claim(s) 6-8, because the claims merely recite an intended use, the categories of creations are deemed to be non-functional descriptive data, and are rejected similarly as claim 1 above.

Regarding independent claim(s) 13, Gupta discloses a wizard for collecting content (Fig. 8, 262). Gupta teaches that the content is stored in a database (para. 47). Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). Bayeh teaches an XSL parser (col. 9, ll. 5-8), as well as a plurality of XSL processor for different presentation requirements, (col. 8, ll. 55-57), which would encompass a different device. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22).

Regarding independent claim(s) 14, Gupta discloses a graphical prompt for soliciting user input (Fig. 8, 262). Gupta teaches that the content is stored in a database (para. 47). Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). Bayeh teaches a first XSL parser to generate a first HTML file (col. 9, ll. 5-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22).

Regarding dependent claim(s) 15, Gupta does not teach generating an HTML file. Bayeh teaches a second XSL processor for different presentation requirements, (col. 8, ll. 55-57), which would encompass a different device. It would have been obvious to one of ordinary skill in the

art at the time of the invention to format the information as HTML because browsers expected to receive HTML (col. 2, ll. 52-53).

Regarding independent claim(s) 16, Gupta discloses input graphics (Fig. 8, 262). Gupta teaches that the content is stored in a database (para. 47). Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). Bayeh teaches a first XSL parser to generate a first HTML file (col. 9, ll. 5-8). Bayeh teaches a second XSL processor for different presentation requirements, (col. 8, ll. 55-57), which would encompass a different device. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22).

Regarding independent claim(s) 17, Gupta discloses a user interface (Fig. 8, 262). Gupta discloses a prompt and input box for entering a start time and end time capable of selecting a particular frame (Gupta, para. 61). Gupta teaches that the content is stored in a database (para. 47). Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). Bayeh teaches a first XSL parser to generate a first HTML file (col. 9, ll. 5-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22).

Regarding dependent claim(s) 18, Gupta does not teach generating an HTML file. Bayeh teaches a second XSL processor for different presentation requirements, (col. 8, ll. 55-57), which would encompass a different device. It would have been obvious to one of ordinary skill in the

art at the time of the invention to format the information as HTML because browsers expected to receive HTML (col. 2, ll. 52-53).

Regarding independent claim(s) 19, Gupta entering content information (Fig. 8, 262). Gupta teaches that the content is stored in a database (para. 47). Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). Bayeh teaches a first XSL parser to generate a first HTML file (col. 9, ll. 5-8). Bayeh teaches a second XSL processor for different presentation requirements, (col. 8, ll. 55-57), which would encompass a different device. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

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